

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Boyy Inc.*

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Serial No. 87298620  
Serial No. 87298664  
Serial No. 87298682  
(Consolidated)

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Mary A. Donovan of Cowan, Liebowitz & Latman, P.C.,  
for Boyy Inc.

Alexandra Suarez, Trademark Examining Attorney,<sup>1</sup> Law Office 120,  
David Miller, Managing Attorney.

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Before Cataldo, Goodman, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Boyy Inc. (“Applicant”) seeks registration on the Principal Register of the mark BOYY in standard characters in three applications covering the following goods: (1) “sunglasses; eyeglasses,” in International Class 9; (2) “hats; caps; headbands; scarves;

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<sup>1</sup> Trademark Examining Attorney Joshua S. Toy examined the applications and issued the final refusals to register that are the subject of these appeals. Trademark Examining Attorney Suarez filed the Patent and Trademark Office’s briefs. We will refer to both of them as the “Examining Attorney.”

shoes; clothing, namely, sweatshirts, sweatsuits, t-shirts,” in International Class 25; and (3) “clothing, namely, tops, bottoms, dresses, skirts, blouses, shirts, pants, sweaters, coats, suits, jackets, vests, stockings, belts; slippers; boots,” in International Class 25.<sup>2</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark in each application on two grounds: (1) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark BOY in standard characters for “jewelry; wristwatches,” in International Class 14, and for “belts for clothing, footwear for men and women; headgear, namely, hats, cap; men’s and women’s jackets, coats, trousers, vests; men’s suits, women’s suits; men’s underwear; sweatshirts for babies, adults, children, women, men; T-shirts for babies, adults, children, women, men; women’s clothing, namely shirts, dresses, skirts, blouses,” in International Class 25,<sup>3</sup> as to be likely, when used on or connection with the goods identified in each of Applicant’s applications, to cause confusion, to cause mistake, or to deceive; and (2) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant’s mark is merely descriptive of the goods identified in the applications.

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<sup>2</sup> The first two applications, Serial Nos. 87298620 in Class 9 and 87298664 in Class 25, were filed on January 12, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claims of first use of the mark and first use of the mark in commerce since at least as early as February 2012. The third application, Serial No. 87298682 in Class 25, was filed on January 12, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

<sup>33</sup> Registration No. 4722172 issued on the Principal Register on April 21, 2015 on the basis of a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

When the Examining Attorney made the refusals final, Applicant appealed and requested reconsideration of each refusal, which was denied. Because the three appeals involve substantively identical refusals as to different goods, we have consolidated the appeals sua sponte and will decide them in this single opinion. *See In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012).<sup>4</sup> We affirm both refusals to register in all three cases.

### **I. Records on Appeal**

The records in the three applications are virtually identical and contain the following:

1. Internet webpages showing the offering of the goods identified in the cited registration and in the three applications under the same mark, made of record by the Examining Attorney;<sup>5</sup>
2. Definitions of the word “boy” from THE AMERICAN HERITAGE DICTIONARY (ahdictionary.com) and the MERRIAM-WEBSTER DICTIONARY (merriam-webster.com), made of record by the Examining Attorney;<sup>6</sup>
3. Pages from the Patent and Trademark Office’s Trademark Search and Document Retrieval (“TSDR”) database regarding Applicant’s Registration No. 3302538 of the mark BOYY in standard characters for “bags, namely,

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<sup>4</sup> Applicant and the Examining Attorney have filed briefs in each appeal that differ in substance only with respect to references to the goods for which Applicant seeks registration in each application. We will cite to briefs in each appeal as appropriate.

<sup>5</sup> January 31, 2017 Office Actions at 7-95.

<sup>6</sup> January 31, 2017 Office Actions at 96-98; August 7, 2017 Office Action at 39 (Serial No. 87298620); August 7, 2017 Office Actions at 7 (Serial Nos. 87298664 and 87298682).

- purses, pocketbooks, duffels, clutches, evening bags, weekend bags, messenger bags, wallets, and change purses,” made of record by Applicant;<sup>7</sup>
4. Third-party registrations of marks, unrelated to those at issue herein, for goods in both International Class 9 and International Class 18, made of record by Applicant;<sup>8</sup>
  5. Pages from Applicant’s website at boyybag.com describing Applicant’s business and showing the prices of Applicant’s goods sold under the BOYY mark, made of record by the Examining Attorney<sup>9</sup> and Applicant;<sup>10</sup>
  6. Articles regarding Applicant and its business, made of record by Applicant;<sup>11</sup>
  7. Third-party advertisements for Applicant’s goods, made of record by Applicant;<sup>12</sup>

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<sup>7</sup> July 31, 2017 Response to Office Action at 16-19 (Serial No. 87298620); July 31, 2017 Responses to Office Actions at 18-21 (Serial Nos. 87298664 and 87298682).

<sup>8</sup> July 31, 2017 Response to Office Action at 20-31 (Serial No. 87298620); July 31, 2017 Responses to Office Actions at 22-39 (Serial Nos. 87298664 and 87298682).

<sup>9</sup> August 7, 2017 Office Actions at 8.

<sup>10</sup> July 31, 2017 Response to Office Action at 32-36 (Serial No. 87298620); July 31, 2017 Responses to Office Actions at 40-45 (Serial Nos. 87298664 and 87298682).

<sup>11</sup> July 31, 2017 Response to Office Action at 37-105 (Serial No. 87298620); July 31, 2017 Responses to Office Actions at 46-113 (Serial Nos. 87298664 and 87298682). Many of the articles are identified as having appeared in foreign publications. *See, e.g.*, July 31, 2017 Response to Office Action (Serial No. 87298620) at 48-49, 54, 57-58, 60, 76, 79-80, 82-87, 90, 95-97 (Thailand), 53 (Australia), 59, 64 (United Kingdom), 61 (France), 62-63 (Japan), 72 (Hong Kong), 89 (Brazil), and 91 (Germany). In the absence of evidence of the exposure of these articles in the United States, they have little, if any, probative value in our decisions.

<sup>12</sup> July 31, 2017 Response to Office Action at 105-107 (Serial No. 87298620); July 31, 2017 Responses to Office Actions at 114-116 (Serial Nos. 87298664 and 87298682).

8. Third-party registrations of marks for both one or more of the goods identified in the cited registration and one or more of the goods identified in Applicant's applications, made of record by the Examining Attorney;<sup>13</sup> and
9. Third-party registrations of "BOY"-formative marks for goods in various International Classes, made of record by Applicant.<sup>14</sup>

## II. Analysis of Likelihood of Confusion Refusals

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *du Pont* factor that is relevant and for which there is record evidence. *See, e.g., M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015).

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<sup>13</sup> August 7, 2017 Office Action at 2-4, 8-36 (Serial No. 87298620); August 7, 2017 Office Action at 9-65 (Serial No. 87298664); August 7, 2017 Office Action at 31-107 (Serial No. 87298682).

<sup>14</sup> February 7, 2018 Requests for Reconsideration (4 TTABVUE 7-15 in Serial Nos. 87298620, 87298664, and 87298682). Applicant stated in each request for reconsideration that the "evidence submitted consists of our final argument with exhibits for reconsideration." 4 TTABVUE 1.

Two key factors in every § 2(d) case are the similarity or dissimilarity of the marks and the similarity or dissimilarity of the goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The Examining Attorney addresses these two key factors in all three appeals, and also responds to Applicant’s arguments on other *du Pont* factors. Applicant concedes the similarity of the goods in all three appeals,<sup>15</sup> and focuses on the similarity of marks factor, the fourth *du Pont* factor regarding the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” *du Pont*, 177 USPQ at 567, the sixth *du Pont* factor regarding the “number and nature of similar marks in use on similar goods,” *id.*, and the impact of the existence of Applicant’s incontestable registration of BOYY for bags, which generally falls within the thirteenth *du Pont*, “[a]ny other established fact probative of the effect of use.” *Id.*; see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1747-48 (TTAB 2018); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017); *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012).

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<sup>15</sup> Applicant “agrees with the Examining Attorney that the goods are overlapping and/or similar, but disagrees as to whether the source of the goods is likely to be confused.” 7 TTABVUE 7 (Serial Nos. 87298620, 87298664, and 87298682).

**A. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers**

The second *du Pont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014), while the third *du Pont* factor “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* at 1161. The analysis of these factors is premised on the identifications of goods in the applications and in the cited registration. *Id.* at 1161-63; *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

The identified goods need not be identical or even competitive to find a likelihood of confusion. *See, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). As noted above, “Applicant agrees with the Examining Attorney that the goods are overlapping and/or similar,” 7 TTABVUE 7, but we will analyze the degree of their similarity to determine the

weight that we should give this *du Pont* factor in our balancing of the relevant factors.<sup>16</sup>

### **1. Application Serial Nos. 87298664 and 87298682**

The goods identified in the cited registration include “belts for clothing, footwear for men and women; headgear, namely, hats, cap[s]; men’s and women’s jackets, coats, trousers, vests; men’s suits, women’s suits; men’s underwear, sweatshirts for babies, adults, children, women, men; T-shirts for babies, adults, children, women, men; women’s clothing, namely shirts, dresses, skirts, blouses,” in Class 25.<sup>17</sup> Applicant’s two Class 25 applications include goods identified as “hats,” “caps,” “shoes,” “sweatshirts,” and “t-shirts” (Serial No. 87298664), and as “dresses,” “skirts,” “blouses,” “shirts,” “jackets,” “vests,” “belts,” “slippers,” and “boots” (Serial No. 87298682). These particular goods in the Class 25 applications are either literally identical to counterpart goods identified in the cited registration, or legally identical to goods identified in the cited registration because they are encompassed within them.<sup>18</sup> See *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The partial identity and legal

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<sup>16</sup> Applicant does not respond to what it describes as the Examining Attorney’s argument that “the goods are available in the same trade channels,” 7 TTABVUE 8 (Serial Nos. 87298620, 87298664, and 87298682), and thus implicitly concedes the similarity of the channels of trade.

<sup>17</sup> The Section 2(d) refusals may be affirmed if there is a likelihood of confusion with respect to any of the goods identified in the applications and in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *FabFitFun*, 127 USPQ2d at 1672.

<sup>18</sup> For example, the goods broadly identified in the cited registration as “footwear for men and women” encompass the goods identified more narrowly as “shoes” in Serial No. 87298664 and as “slippers” and “boots” in Serial No. 87298682.

identity of the goods weighs heavily in favor of a finding of a likelihood of confusion with respect to the Class 25 applications. *See, e.g., In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015).

In addition, “[w]e must presume that Applicant’s and Registrant’s goods will be sold in the same channels of trade and will be bought by the same classes of customers, because the goods are identical and legally identical in part and there are no limitations as to channels of trade or classes of purchasers in either the application[s] or cited registration.” *i.am.symbolic*, 127 USPQ2d at 1629 (citing *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). The third *du Pont* factor thus also supports a finding of a likelihood of confusion with respect to the Class 25 applications.

## **2. Application Serial No. 87298620**

The goods identified in Applicant’s Class 9 application are “sunglasses” and “eyeglasses.” The Examining Attorney made of record multiple third-party webpages offering, under the same mark, sunglasses or eyeglasses, on the one hand, and jewelry, wristwatches, and/or one or more of the clothing items identified in the cited registration, on the other hand,<sup>19</sup> as well as 10 use-based, third-party registrations of marks for both sunglasses and/or eyeglasses, on the one hand, and jewelry, wristwatches, and/or one or more of the clothing items identified in the cited

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<sup>19</sup> January 31, 2017 Office Actions at 7-65 (Calvin Klein clothing, sunglasses and eyeglasses, wristwatches, and jewelry), 66-70 (H&M clothing, jewelry, and wristwatches), 71-89 (Gap sunglasses and clothing), 90-95 (Ralph Lauren eyeglasses and clothing).

registration, on the other hand.<sup>20</sup> Applicant itself also made of record two use-based, third-party registrations of the same mark for sunglasses and eyeglasses, and clothing.<sup>21</sup> This evidence is probative of a relationship between the goods identified in Applicant's Class 9 application and the goods identified in the cited registration. *See, e.g., Aquamar*, 115 USPQ2d at 1126 n.5 (citations omitted). The second *du Pont* factor supports a finding of a likelihood of confusion with respect to Application Serial No. 87298620.

The Examining Attorney's evidence also establishes that the goods are sold through the same trade channels, including the websites of retailers such as Belk, Macy's, and Gap, and fashion companies such as Calvin Klein,<sup>22</sup> to the same general classes of consumers. The third *du Pont* factor thus also supports a finding of a likelihood of confusion with respect to Application Serial No. 87298620.

### **B. Similarity or Dissimilarity of the Marks**

The first *du Pont* factor considers "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re*

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<sup>20</sup> August 7, 2017 Office Actions at 2-4, 8-36.

<sup>21</sup> July 31, 2017 Responses to Office Action at 23-24 (MARC JACOBS), 30-31 (J. CREW).

<sup>22</sup> We infer that the goods available through the websites are also available in the brick-and-mortar world outlets of these companies.

*White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (quotation omitted). “The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018).

As discussed above, the goods identified in Application Serial Nos. 87298664 and 87298682 are identical in part to goods identified in the cited registration. This reduces the degree of similarity between the marks required to find a likelihood of confusion in those appeals. *See, e.g., Coach Servs.*, 101 USPQ2d at 1721; *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012) (“Where the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant concedes that the differences between the marks BOY and BOYY are “slight,” 7 TTABVUE 7 (Serial Nos. 87298620, 87298664, and 87298682), and makes essentially the same arguments in each appeal that those slight differences are sufficient to avoid a likelihood of confusion. First, Applicant argues that “the appearance of BOYY derives significant contribution from the additional ‘Y’, which connotes a specific point of reference in consumers’ minds,” *id.* at 10, and that its

“BOYY mark creates a different overall commercial impression from the Cited Mark.” *Id.* at 8. According to Applicant, “it is not clear that a consumer would immediately equate the mark BOYY with the common term ‘boy’ but might think it an acronym or a foreign term.” *Id.* Applicant “believes that the unusual spelling creates a different commercial impression than ‘boy’ alone,” *id.*, and that the “consuming public simply will not see Applicant’s BOYY Mark and assume or believe it was meant to be ‘boy.’” *Id.* at 10.

Second, Applicant argues that “there is no rule that confusion is automatically likely if a junior user has a mark that begins with the beginning of another’s mark,” *id.* at 9, that “the mere fact that Applicant’s Mark and the Cited Mark both begin with the letters ‘boy’ does not render the marks confusingly similar,” *id.*, and that “there is no rule that confusion is automatically likely even if a junior user has a mark that contains in part the whole of another’s mark.” *Id.* at 10.<sup>23</sup>

The Examining Attorney argues that the “marks are highly similar as the marks are phonetic equivalents that differ by only one letter.” 9 TTABVUE 4 (Serial Nos. 87298620, 87298664, and 87298682). In response to Applicant’s arguments regarding the significance of the additional letter “Y” in its mark, the Examining Attorney acknowledges the slight difference in spelling, but argues that “the marks nonetheless sound the same” and further argues that “[t]here is no evidence of record

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<sup>23</sup> Applicant also argues that “the term BOYY is already indisputably linked with Applicant, as is evidenced by Applicant’s incontestable registration for related goods and for the identical mark BOYY.” *Id.* at 10. We address this argument below in our discussion of the thirteenth *du Pont* factor.

to suggest that the wording ‘BOYY’ written with two letters ‘Y’ refers to a foreign acronym of [sic] which consumers in the United States would recognize.” *Id.* at 7. In response to Applicant’s arguments regarding the absence of any per se rules that mandate a finding of confusing similarity where marks contain common elements, the Examining Attorney argues that “Applicant’s mark does not merely ‘begin’ with another’s mark, applicant’s mark entirely incorporates the registrant’s mark and differs by only one letter” and that “[t]here are no other words or phrases to differentiate applicant’s mark from the registrant’s mark.” *Id.* at 8. According to the Examining Attorney, “the terms ‘BOYY’ and ‘BOY’ appear and sound highly similar as to create the same overall commercial impression amongst consumers.” *Id.*<sup>24</sup>

We find that the cited mark BOY and the applied-for mark BOYY are quite similar. Applicant does not dispute that the marks are identical in sound. With respect to appearance, the marks contain the same word BOY and differ only by the presence of an extra “Y” in BOYY. We disagree with Applicant that the “appearance of BOYY derives significant contribution from the additional ‘Y’, which connotes a specific point of reference in consumers’ minds,” and that “the differences in the respective marks, which most notably include a distinctive, even jarring, spelling, distinguish the marks.” 7 TTABVue 10. BOYY appears simply to be a misspelling or

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<sup>24</sup> The Examining Attorney also correctly notes in her discussion of the similarity of the marks that the Trademark Act protects against both “forward” confusion, where the applicant’s goods will be perceived as those of the cited registrant, or as sponsored or authorized by the cited registrant, and “reverse” confusion, where the “senior user may experience diminution or even loss of its mark’s identity and goodwill due to extensive use of a confusingly similar mark by the junior user’ for related goods.” *Id.* (quoting *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1752 (Fed. Cir. 2017)). The mode of analysis of the similarity of the marks, however, does not differ depending on the underlying theory of likelihood of confusion.

fanciful spelling of BOY.<sup>25</sup> As discussed below, authors of articles about Applicant and its BOYY products have used the fact that BOYY resembles BOY to mimic common phrases or expressions that include the word BOY.

With respect to connotation and commercial impression, there is no evidence in the record to support Applicant's claims that BOYY would be perceived as an acronym or foreign term, or that the "consuming public simply will not see Applicant's BOYY Mark and assume or believe it was meant to be 'boy'," *id.*, and some of Applicant's own evidence shows just the opposite.

Applicant made of record various articles in United States publications about Applicant's BOYY business and products. One such article about the debut of Applicant's products at a major American retailer, and the professional and personal relationship between Applicant's co-founders Jesse Dorsey and Wannasari Kongman, is entitled "Oh Boyy, a Celebratory Debut at Bergdorf Goodman," which involves a play on the expression "Oh boy." The article ends with a sentence discussing Applicant's founders' future plans to expand "even more in New York City, where they first met, where they fell in love, and where they brought to life their baby,

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<sup>25</sup> Applicant cites numerous cases for the propositions that "there is no rule that confusion is automatically likely if the junior user has a mark that begins with the beginning of another's mark" and that "the mere fact that Applicant's Mark and the Cited Mark both begin with the letters 'boy' does not render the marks confusingly similar." 7 TTABVUE 9. It has long been the law that "prior decisions on different marks used under different circumstances are of little value in deciding a specific issue of likelihood of confusion." *Jaquet-Girard S.A. v. Girard Perregaux & Cie., S.A.*, 423 F.2d 1395, 165 USPQ 265, 266 (CCPA 1970). In any event, as the Examining Attorney correctly notes, "[t]here are no other words or phrases to differentiate applicant's mark from the registrant's mark," 9 TTABVUE 8, and all but one of the cases cited by Applicant involved two marks whose differences resulted from the presence in one of the marks of an additional word or term.

Boyy.”<sup>26</sup> The last words of this sentence are a play on the term “baby boy.” The “About” page on Applicant’s website also references when Applicant’s founders’ “collaborative brainchild BOYY was born,” a similar play on the similarity of BOYY to the word “boy.”<sup>27</sup> An article about the introduction of Applicant’s products in the United States is entitled “Boyy, Oh Boyy,” a play on the expression “boy, oh boy.”<sup>28</sup> An article from Thestylephile.com is entitled “Boyys on the Side,” a play on the phrase “boys on the side.”<sup>29</sup> These uses of BOYY in lieu of BOY suggest that the mark BOYY is far more likely to be understood by consumers simply as a play on the word BOY than as an acronym or foreign term that is not derived from the word BOY. We find that the marks have similar meanings.

The marks are identical in sound, and highly similar in appearance, connotation, and commercial impression. The first *du Pont* factor supports a finding of a likelihood of confusion in all three appeals, particularly with respect to the Class 25 applications involving identical goods.

### **C. Third-Party Marks**

The sixth *du Pont* factor concerns the “number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567. Applicant argues that “[t]here are hundreds of third-party registrations for BOY-formative marks, which preceded the

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<sup>26</sup> July 31, 2017 Response to Office Action at 38 (Serial No. 87298620).

<sup>27</sup> August 7, 2017 Office Action at 40 (Serial No. 87298620).

<sup>28</sup> *Id.* at 40. A second article on that subject states that Ms. Kongman is nicknamed “Boy” and the author claims that a company “rep told me that it was just too hard to copyright Boy, hence Boyy.” *Id.* at 41.

<sup>29</sup> *Id.* at 52.

filing of the Cited Mark,” and that as a result, “no one person can claim exclusive rights to the word ‘boy’ for clothing or related goods, and an existing registration for ‘boy’ in no distinguishing form should [not] be allowed to block an application for a mark containing ‘boy’ for clothing or related goods even if the differences are slight.” 7 TTABVUE 7 (Serial Nos. 87298620, 87298664, and 87298682).<sup>30</sup> Applicant relies on copies of the certificates of registration of the marks PEP BOYS, ASTRO BOY, BOY MEETS GIRL, COMME des GARCONS (translated as “like the boys”), and SACKBOY, all for various items of clothing and other goods and made of record on Applicant’s requests for reconsideration.<sup>31</sup>

In an ex parte appeal, “[t]he purpose of [an applicant’s] introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Palm Bay*, 73 USPQ2d at 1694 (internal citations omitted). In our *du Pont* analysis, “we must ‘adequately account for the apparent force of [third-party use and registration] evidence,’ regardless of whether ‘specifics’ pertaining to the extent and impact of such use have been proven.”

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<sup>30</sup> Applicant also claims that there “are over 800 citations of active applications and registrations for clothing products per TTABVue.” 7 TTABVUE 7 (Serial Nos. 87298620, 87298664, and 87298682). Applicant argues that the putative co-existence on the Register of these unspecified marks for clothing is probative of whether “the source of the goods is likely to be confused.” *Id.* The cited record evidence, however, comprises only 15 third-party registrations, several of which are for the same mark and, as discussed above, only five are for a BOY-formative mark. July 31, 2017 Response to Office Action at 20-31; February 7, 2018 Request for Reconsideration (4 TTABVUE 7-15). Moreover, the Board’s well-established practice is not to take judicial notice of third-party registrations. *See generally* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) Section 1208.02 (June 2018) and cases cited therein.

<sup>31</sup> 4 TTABVUE 7-15.

*Inn at St. John's*, 126 USPQ2d at 1746 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015)).

Here, there is no evidence of third-party use, and only five third-party registrations of BOY-formative marks for the same or similar goods, none of which marks are nearly as similar to either BOY or BOYY as those marks are to each other. We agree with the Examining Attorney that “the few similar third-party registrations submitted by applicant which contain the wording ‘BOY’ are insufficient to establish that the wording ‘BOY’ is weak or diluted.” 9 TTABVUE 12. *See i.am.symbolic*, 123 USPQ2d at 1751-52 (holding that evidence of a few third-party registrations of similar marks “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present” in *Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015)); *Inn at St. John's*, 126 USPQ2d at 1746. This *du Pont* factor is neutral in our analysis.

#### **D. Sophistication of Purchasers**

The fourth *du Pont* factor is the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *du Pont*, 177 USPQ at 567. Applicant argues that its mark “is also not likely to be confused with the Cited Mark because American consumers of sunglasses, eyeglasses, clothing, footwear and bags are very brand conscious at all levels” and that “Applicant’s brand is clearly high-end” and retails “from anywhere for several hundred dollars to several thousand dollars for an item.” 7 TTABVUE 13 (Serial Nos. 87298620, 87298664, and 87298682).

Applicant cites its website at boyybag.com, articles about its business, and the websites of retailers such as Bergdorf Goodman, Neiman Marcus, and Nordstrom showing the high prices of its goods,<sup>32</sup> which evidence Applicant argues collectively reflects its recognition “in the trade as a premium luxury brand. . . .” *Id.*

We must determine the level of sophistication of the relevant purchasers on the basis of the goods identified in Applicant’s applications because those identifications “determine the post-grant benefit of registration.” *Stone Lion*, 110 USPQ2d at 1162. There are no restrictions or limitations in Applicant’s identifications of goods to “high-end” or “premium luxury” sunglasses, eyeglasses, or clothing, or to a class of purchasers that consists solely of “[c]onsumers looking for high end apparel, footwear and bags . . . .” 7 TTABVUE 14. The absence of such restrictions vitiates Applicant’s sophisticated consumer argument.

Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof.

*Jump Designs*, 80 USPQ2d at 1374.

We thus must presume that the identified goods include all types of sunglasses, eyeglasses, and clothing, including both high-end and low-end goods, and that the

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<sup>32</sup> July 31, 2017 Responses to Office Action at 11-12, 40-116.

potential purchasers of those goods run the gamut from consumers looking for luxury items at Bergdorf Goodman to consumers hunting for bargains in discount outlets.<sup>33</sup> *Stone Lion*, 110 USPQ2d at 1163 (Board “properly considered all potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement” as well as applicant’s current sophisticated investors); *Octocom*, 16 USPQ2d at 1788 (“an application with an identification of goods having no restriction on trade channels obviously is not narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers”).<sup>34</sup>

“Board precedent requires [our] decision to be based ‘on the least sophisticated potential purchasers.’” *Stone Lion*, 110 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)). Ordinary consumers of sunglasses, eyeglasses, and clothing may exercise little care in the purchasing process, and even purchasers of high-end goods are not immune from confusion when similar marks are used in connection with identical or related goods. *Id.* at 1163-64; *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690-91 (Fed. Cir. 1993); *Fiserv*,

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<sup>33</sup> The record is devoid of evidence that purchasers of sunglasses, eyeglasses, and clothing “are very brand conscious at all levels.” 7 TTABVUE 13.

<sup>34</sup> Applicant itself selected these broad and unrestricted identifications of goods, which “determine the scope of the post-grant benefit of registration.” *Stone Lion*, 110 USPQ2d at 1162. “Parties that choose to recite [goods] in their trademark application that exceed their actual [goods] will be held to the broader scope of the application.” *Id.* at 1163.

*Inc. v. Elec. Transaction Sys. Corp.*, 115 USPQ2d 1913, 1921-22 (TTAB 2015). This *du Pont* factor is neutral in our analysis.

**E. Applicant's Existing Registration of BOYY in Class 18**

Applicant made of record its Registration No. 3302538 for the mark BOYY in standard characters for “bags, namely, purses, pocketbooks, duffels, clutches, evening bags, weekend bags, messenger bags, wallets, and change purses.”<sup>35</sup> The registration issued in 2007, became incontestable in 2013, and was renewed in 2016, and it has coexisted on the Principal Register with the cited registration for about three and one-half years.

Applicant argues that “it would unfairly prejudice Applicant to prevent it from expanding to closely related goods due to an intervening registration” and that to “deny registration of Applicant’s mark due to the intervening BOY registration would be unjust.” 7 TTABVUE 13 (Serial Nos. 87298620 and 87298682). Applicant claims variously that its registration, and its pending Application Serial No. 87298664, give it priority of use of its BOYY mark over the registrant, and that “Applicant is merely moving into a natural area of expansion in which he [sic] has been selling for many years,” 7 TTABVUE 12; that Applicant’s applied-for mark and its registered mark are legal equivalents, entitling it to “claim priority in its mark based on the first use of date of the earlier mark which is its legal equivalent,” *id.*; that the goods identified in its registration and the goods identified in its applications are closely related, *id.* at 12-13; that “[g]iven Applicant’s priority, consumers will associate Applicant’s goods

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<sup>35</sup> July 31, 2017 Response to Office Action at 18-21.

with Applicant's BOYY mark as identifying a single source different from that of the goods sold under the Cited Mark," *id.* at 13; and that "[g]iven that the mark in Applicant's BOYY Registration and the Application herein are the same, the owner of the Cited Mark could not be damaged by the issuance of a new registration for Applicant's mark." *Id.* (citing *Morehouse Mfg. Co. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969)).

These arguments are unavailing, principally because they import into these *ex parte* appeals doctrines that apply primarily, if not exclusively, in *inter partes* cases. Applicant argues that it has a right to expand its registration of BOYY from bags to the goods in the subject applications because those goods are within the natural zone of expansion of use of its mark on bags, but the natural zone of expansion doctrine applies primarily in the *inter partes* context, as a means to establish priority. *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015).<sup>36</sup> In the *ex parte* context, the concept is typically used to determine whether the goods in the application are within the natural zone of expansion of the goods in the cited registration, *see, e.g., In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB

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<sup>36</sup> In that regard, we note that the cited registration is fewer than five years old and thus remains subject to cancellation on the ground of priority and likelihood of confusion. 15 U.S.C. § 1064(1). Applicant claims that "[s]ince Applicant's BOYY Mark was registered first, Applicant has priority over the Cited Mark," 7 TTABVUE 13, but Applicant did not petition to cancel the cited registration under Section 2(d), which would have been the proper means through which to assert Applicant's claimed superior rights. *Cf. In re Detroit Athletic Co.*, 2018 WL 4288981, \*7 (Fed. Cir. September 10, 2018) (precedential) (attack on cited registration must be asserted in a cancellation proceeding); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1410 (TTAB 2018) (same) (citing *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997)).

2007), not whether the applicant can register its mark over a registered mark because it owns a prior registration of the applied-for mark for related goods.

Applicant's reliance on the *Morehouse* case is similarly misplaced. "The Morehouse defense is an equitable affirmative defense which, in appropriate circumstances, may be asserted by a defendant/applicant in an *inter partes* proceeding." *Strategic Partners*, 102 USPQ2d at 1399. "It is based on the principle that '[a]n opposer cannot be 'damaged' within the meaning of Lanham Act §13 by registration of a mark for particular goods or services if applicant owns an existing registration for the same or substantially identical mark for the same or substantially identical goods.'" *Id.* (internal quotation omitted). "The defense does not apply in an *ex parte* context." *Id.* at 1400.

We must consider Applicant's registration, however, under the thirteenth *du Pont* factor, which "relates 'to any other established fact probative of the effect of use.'" *Id.* at 1399 (citing *du Pont*, 177 USPQ 567). "This final factor accommodates the need for flexibility in assessing each unique set of facts." *Id.* In our most recent discussion of this factor, we noted that where, as here, "an applicant owns a prior registration that is over five years old and the mark is substantially the same as in the applied-for application, this can weigh against finding that there is a likelihood of confusion," *Inn at St. John's*, 126 USPQ2d at 1748, and we have held that in the balancing of the *du Pont* factors, this factor may sometimes be decisive.

In *Strategic Partners*, the Board reversed a refusal to register ANYWEAR in stylized lettering for footwear over the registered mark ANYWEAR BY JOSIE

NATORI for clothing. The applicant owned an incontestable registration of ANYWEARS in standard characters for footwear and hosiery that had co-existed with the cited registration for more than five years. In its *du Pont* analysis, the Board found that “there is no question that the marks are similar” and that the subject “goods often emanate from the same source, travel in the same channels of trade, and are bought by the same classes of purchasers,” and that it “would conclude, under usual circumstances, that confusion is likely to occur among consumers in the marketplace.” *Strategic Partners*, 102 USPQ2d at 1398-99. The Board nevertheless reversed the refusal to register because the “present case involves the unique situation presented by the coexistence of applicant’s existing registration with the cited registration for over five years, when applicant’s applied-for mark is substantially similar to its existing registered mark, both for identical goods.” *Id.* at 1400. The Board found that, under these circumstances, the thirteenth *du Pont* factor “outweighs the others and leads us to conclude that confusion is unlikely.” *Id.*

This case differs from *Strategic Partners* in two critical respects. First, the cited mark and Applicant’s registered BOYY mark in Class 18 have coexisted on the Principal Register for about three and one-half years, a period shorter than the five plus years in *Strategic Partners* and roughly the same period of coexistence as in *USA Warriors Ice Hockey Program*, in which the Board found such coexistence to be “a relevant consideration,” but one that did “not outweigh the other *du Pont* factors in this case.” 122 USPQ2d at 1793. Second, while Applicant has previously registered the identical mark for which it seeks registration in the three cases before us, the

goods in Applicant's prior registration are not identical or legally identical to the goods identified in Applicant's three current applications. *Cf. Strategic Partners*, 102 USPQ2d at 1399 (the facts that applicant owned "a registration for a substantially similar mark for the identical goods" and "that applicant's registration and the cited registration ha[d] coexisted for over five years" combined to "tip the scale in favor of applicant and a finding of no likelihood of confusion"). The thirteenth *du Pont* factor thus weighs only slightly in favor of a finding of no likelihood of confusion.

#### **F. Conclusion**

In balancing the relevant *du Pont* factors, the marks are quite similar, the goods are identical or legally identical (Serial Nos. 87298664 and 87298682), or otherwise closely related (Serial No. 87298620), and the goods travel through the same channels of trade and are purchased by the same classes of consumers. These *du Pont* factors all support a finding of a likelihood of confusion. The *du Pont* factors regarding the impact of third-party marks and the sophistication of purchasers are neutral. Although the coexistence of Applicant's Class 18 registration of BOYY with the cited registration of BOY weighs slightly against a finding of a likelihood of confusion, we find, on the record as a whole, that it does not outweigh the other *du Pont* factors. *USA Warriors Ice Hockey Program*, 122 USPQ2d at 1793 n.10 ("The issuance of Applicant's first registration does not require the approval of a second registration if, on the facts of the case, it would be improper to do so under the governing legal standard") (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016)); *see also i.am.symbolic*, 123 USPQ2d at 1751 (the applicant's

ownership of a Class 25 registration did “not give it the ‘right to register [the same] mark on an expanded line of goods [in the applications at issue] where the use of the mark covered by such registration would lead to a likelihood of confusion, mistake or deception.”) (quoting *Jacks--Evans Mfg. Co. v. Jaybee Mfg. Co.*, 481 F.2d 1342, 179 USPQ 81, 83 (CCPA 1973)).

We find that Applicant’s use of BOYY for the goods identified in its three applications is likely to cause consumers to believe mistakenly that those goods originate with, or are sponsored or authorized by, the owner of the cited registration of BOY, and we accordingly affirm the refusals to register based on Section 2(d) of the Trademark Act.

### **III. Analysis of Mere Descriptiveness Refusals**

We turn next to the Examining Attorney’s separate refusals to register BOYY on the ground that the marks are merely descriptive of the goods identified in the three applications. Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).<sup>37</sup> A mark is “merely descriptive” within the meaning of § 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of

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<sup>37</sup> In its argument against the Section 2(d) refusal, Applicant claims that its registration of BOYY for bags “is evidence that Applicant’s Mark has become distinctive for use on closely related goods,” 7 TTABVUE 11, but Applicant did not seek registration of its mark on the basis of acquired distinctiveness under § 2(f) in any of its applications.

the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).<sup>38</sup>

Whether a mark is merely descriptive is “evaluated ‘in relation to the particular goods for which registration is sought, the context in which the mark is used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use,’” *Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *Bayer*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). “In other words, we evaluate whether someone who knows what the goods are will understand the mark to convey information about them.” *Id.* at 1515 (citing *DuoProSS Meditech Corp. v. Inviro Med.*

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<sup>38</sup> A “mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods] for which registration is sought.’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1088 (Fed. Cir. 2005)).

*Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)).<sup>39</sup> Evidence that a term is merely descriptive to the relevant purchasing public may be obtained from any competent source, such as dictionaries, newspapers, surveys, labels, packaging, or advertising materials. *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1953 (TTAB 2018) (citing *Bayer*, 82 USPQ2d at 1831 and *Abcor*, 200 USPQ at 218).

The Examining Attorney's argument is essentially the same in each appeal, and may be summarized as follows.<sup>40</sup> The applied-for mark BOYY is a novel spelling or intentional misspelling of the word BOY, and would be perceived as such by purchasers of the goods. 9 TTABVUE 13. The word "boy" means "a male child," and the record shows that the word "boy" is often used in association with the goods in the three applications "to market these goods that are intended to be used by male children and/or male adults." *Id.* at 14 (Serial Nos. 87298620, 87298664, and 87298682). According to the Examining Attorney, a "mark that describes an intended user or group of users of a product or service is merely descriptive," and "the applied-for mark is merely descriptive of the intended users of applicant's goods, namely, goods intended to be used by male children." *Id.*

Applicant also makes essentially the same argument in each appeal, which may be summarized as follows. Applicant's BOYY mark "is not merely descriptive of the

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<sup>39</sup> A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

<sup>40</sup> The Examining Attorney also responds to certain arguments made by Applicant, which we discuss below.

applied-for goods (apparel, footwear and headgear) because a potential customer would not immediately glean the nature of those goods from the mark” inasmuch as “[b]y far, the largest item in Applicant’s product lines are women’s handbags, not items for men or boys.” 7 TTABVUE 15 (Serial Nos. 87298620, 87298664, and 87298682). Applicant’s mark “does not directly convey the nature of Applicant’s goods” because the “goods that Applicant’s BOYY Mark are used in connection with are not for children,” but rather “are high-end sunglasses and eyewear, high-end bags, headwear, footwear and clothing,” as shown on Applicant’s website. *Id.* at 16 (Serial No. 87298620). Finally, Applicant argues that all doubts regarding descriptiveness should be resolved in its favor. *Id.*

In *Fat Boys*, we explained that it “is the Examining Attorney’s burden to show, *prima facie*, that a mark is merely descriptive of an applicant’s goods or services,” and that if “such a showing is made, the burden of rebuttal shifts to the applicant.” *Fat Boys*, 118 USPQ2d at 1513. The Examining Attorney made of record evidence of the meaning of the word “boy,”<sup>41</sup> and evidence that forms of the word “boy” are used to designate eyewear and clothing for young males. We set forth examples below:

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<sup>41</sup> January 31, 2017 Office Actions at 96-98; August 7, 2017 Office Action at 39 (Serial No. 87298620); August 7, 2017 Office Actions at 7 (Serial Nos. 87298664 and 87298682).

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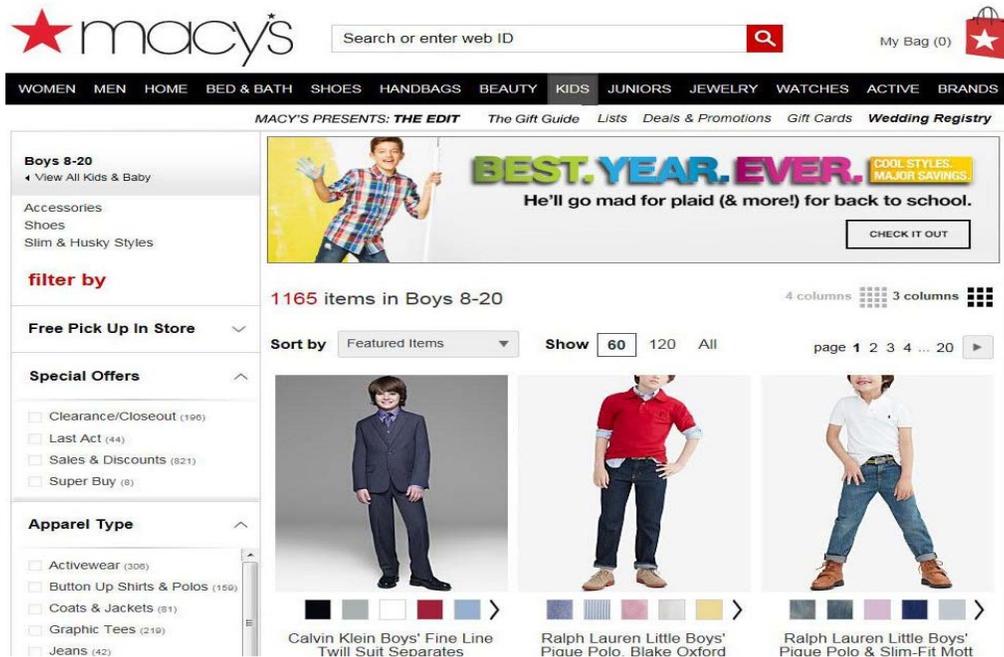
New Arrivals

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42 August 7, 2017 Office Action at 41-44 (Serial No. 87298620).

43 *Id.* at 67-71 (Serial No. 87298620).

44 August 7, 2017 Office Action at 66-68 (Serial No. 87298664); August 7, 2017 Office Action at 9-11 (Serial No. 87298682).



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Applicant does not address or dispute this evidence, and we find that the Examining Attorney has shown that the word “boy” is merely descriptive of one or more of the goods identified in each of the three applications because it immediately conveys that those goods are sized, styled, or otherwise designed for use by young males.<sup>46</sup> See *In re Planalytics Inc.*, 70 USPQ2d 1453, 1454-56 (TTAB 2004) (finding that GASBUYER was merely descriptive of purchasers of services identified as “providing on-line risk management services in the field of pricing and purchase decisions for natural gas”).

<sup>45</sup> August 7, 2017 Office Action at 74-87 (Serial No. 87298664); August 7, 2017 Office Action at 17-30 (Serial No. 87298682).

<sup>46</sup> In that regard, we note that the cited registration of BOY issued under Section 2(f) of the Trademark Act, January 31, 2017 Office Actions at 3, indicating that the Patent and Trademark Office determined that the mark was not inherently distinctive as applied to the identified goods, and thus was not eligible for registration on the Principal Register without a showing of acquired distinctiveness.

Applicant is not seeking to register BOY, of course, but it is well established that a novel spelling or misspelling of a merely descriptive word or term is also merely descriptive if consumers would perceive the different spelling as the equivalent of the descriptive word or term. *See, e.g., In re Calphalon Corp.*, 122 USPQ2d 1153, 1164 (TTAB 2017) (holding that SHARPIN, the phonetic equivalent of “sharpen,” was merely descriptive of knife blocks with built-in sharpeners); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding that URBANHOUSING would be perceived by consumers as the equivalent of the descriptive term “urban housing”); *Planalytics*, 70 USPQ2d at 1455-56 (holding that GASBUYER would be seen as the equivalent of “gas buyer”). In response to the descriptiveness refusals, Applicant does not address or dispute the Examining Attorney’s argument that BOYY will be perceived as a misspelling of BOY. As discussed above, Applicant argued, for likelihood of confusion purposes, that the “consuming public simply will not see Applicant’s BOYY Mark and assume or believe it was meant to be ‘boy,’” 7 TTABVUE 10, but we found that the record did not support this claim, and in fact suggested that consumers would recognize BOYY as a misspelling of BOY.

On the record before us in the three appeals, we find that the Examining Attorney established a prima facie case that BOYY, the phonetic equivalent of BOY, is merely descriptive of one or more of the goods identified in each of the three applications because BOYY immediately conveys that those goods are sized, styled, or otherwise designed for young males, the intended users of the goods. In a descriptiveness case, “[r]ebuttal evidence and argument are the applicant’s province,” *Gyulay*, 3 USPQ2d

at 1010, but Applicant offers nothing to rebut the Examining Attorney's prima facie case other than arguments that misconstrue the test for mere descriptiveness under Section 2(e)(1).

Applicant argues that BOYY "is not merely descriptive of the applied-for goods (apparel, footwear and headgear) because a potential customer would not immediately glean the nature of those goods from the mark," 7 TTABVUE 15 (Serial Nos. 87298620, 87298664, and 87298682), and that BOYY "does not directly convey the nature of Applicant's goods" because the "goods that Applicant's BOYY Mark are used in connection with are not for children," but rather "are high-end sunglasses and eyewear, high-end bags, headwear, footwear and clothing" *Id.* at 16 (Serial No. 87298620).<sup>47</sup> These arguments involve the wrong inquiry. "[T]he question is not whether someone presented only with the mark could guess the goods . . . listed in the identification. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *Mecca Grade Growers*, 125 USPQ2d at 1953 (citing *DuoProSS*, 103 USPQ2d at 1757). The Examining Attorney has shown that a consumer who knows that the goods are eyeglasses, sunglasses, and various clothing items (all without any limitations to "high-end" or women's items) would understand the proposed mark BOYY to convey information about them, namely, that those goods are sized, styled, or otherwise

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<sup>47</sup> Applicant makes the related claim that "[b]y far, the largest item in Applicant's product lines are women's handbags, not items for men or boys." 7 TTABVUE 15 (Serial Nos. 87298620, 87298664, and 87298682). Applicant's focus on the sale of handbags, and the fact that its registration of BOYY for those goods issued without the requirement of a showing of acquired distinctiveness, are irrelevant to the issue of whether BOYY is merely descriptive of the different goods identified in Applicant's applications.

designed for young males, the intended users of the goods, and it does not matter whether a consumer could determine, from the mark alone, that Applicant is actually selling the particular high-end or adult versions of the goods identified in its applications.

The Examining Attorney established that the word BOY is merely descriptive of the goods. “There is nothing in the facts of this case that would lead us to conclude that the term [BOYY] would not, in the same manner, be seen as the equivalent of [BOY]. Therefore, the term [BOYY] would likewise be merely descriptive of applicant’s [goods].” *Planalytics*, 70 USPQ2d at 1456.

**Decision:** The refusals to register are affirmed on both grounds in Application Serial Nos. 87298620, 87298664, and 87208682.